

REMARKS/ARGUMENTS

These remarks are made in response to the Office Action of February 3, 2010 (Office Action). As this response is timely filed within the 3-month shortened statutory period, no fee is believed due. However, the Examiner is expressly authorized to charge any deficiencies to Deposit Account No. 14-1437.

Claim Objections

In the Office Action, Claims 1, 38, and 45 were objected to for reciting the word “can” in the limitation. It was asserted that the term “can” causes the limitation to be indefinite.

Appropriate correction has been made.

Claim Rejections – 35 USC § 103

In the Office Action, Claims 1-4, 10, 38-41, and 44-45 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 6,691,162 to Wick (hereinafter Wick) in view of U.S. Patent 7,266,776 to Quillen, *et al.* (hereinafter Quillen) and in further view of U.S. Patent 6,691,162 to Aggarwal (hereinafter Aggarwal) and U.S. Published Patent Application 2004/0122901 to Sylvain (hereinafter Sylvain). Claims 5 and 42 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Wick in view Quillen, in view of Aggarwal and Sylvain, and in further view of U.S. Patent 6,430,604 to Ogle, *et al.* (hereinafter Ogle).

Although Applicants respectfully disagree with the rejections, Applicants have amended the claims in an effort to even more clearly define the present invention and to facilitate prosecution of the instant application. The claim amendments are fully supported by the original disclosure and no new matter has been introduced.

Aspects of Applicants' Invention

It may be helpful to reiterate certain aspects of Applicants' invention prior to addressing the cited references. One embodiment of the invention, as illustrated by Claim 1, is a method for automatically performing instant messaging actions.

The method can include displaying a user selectable list of subscribers in a graphical user interface of an instant messaging service; selecting at least one subscriber in an inactive state from the list of subscribers in the graphical user interface, the inactive state being any state where an instant messaging session cannot be established with a subscriber, types of inactive state including an offline state, a do-not-disturb state, and an out-of-office state; specifying a particular type of inactive state for each selected subscriber; and displaying in the graphical user interface the selected subscriber in a visually distinctive manner so as to identify the subscriber being monitored for a state change, wherein the visually distinctive manner includes at least one of a distinctive icon, a distinctive font, a distinctive font color, and a distinctive background color.

The method also can include displaying in the graphical user interface options of action to be performed when the selected subscriber becomes active, wherein the options of action are configurable via the graphical user interface; designating at least one action from the options of action for each specified type of inactive state via the graphical user interface, the at least one designated action to be automatically performed with respect to each subscriber when the subscriber's state changes from the specified type of inactive state to an active state; monitoring a state change for each selected subscriber; automatically detecting a state change of the selected subscriber; and automatically executing the designated action associated with the subscriber responsive to the detecting step.

See, e.g., Specification, paragraphs [0034]-[0037], and Figs. 3-4.

The Claims Define Over The Prior Art

The present invention differs from Wick in at least the following aspects.

First, Wick does not disclose specifying a particular type of inactive state for each selected subscriber, wherein types of inactive state include an offline state, a do-not-disturb state, and an out-of-office state, as in the present invention. The advantage of the present invention is that different actions can be designated to the subscribers based on the different types of inactive state of the subscribers. In contrast, Wick does not differentiate among the different types of inactive state, but rather only monitors if a targeted user has signed on to the network. For example, the targeted user may remain in an inactive state (such as a do-not-disturb state) even if the targeted user has signed on.

Second, Wick does not disclose displaying in the graphical user interface the selected subscriber in a visually distinctive manner so as to identify the subscriber being monitored for a state change, wherein the visually distinctive manner includes at least one of a distinctive icon, a distinctive font, a distinctive font color, and a distinctive background color, as in the present invention.

Third, Wick does not disclose that options of action to be performed when a selected subscriber becomes active are configurable via the graphical user interface, as in the present invention. As shown in Fig. 1 of the instant application, the options of action that can be performed when a selected subscriber becomes active can be configured using a "Configure Nonavailability Options" option 136 in the options menu 125.

Fourth, Wick does not disclose designating at least one action from the options of action for each specified type of inactive state via the graphical user interface, the at least one designated action to be automatically performed with respect to each subscriber when the subscriber's state changes from the specified type of inactive state to an active state, as in the present invention. Wick only monitors if a targeted user has signed on to the network, regardless whether the targeted user is inactive or active, or the types of inactive

state. Wick also does not designate different actions to be performed based on the specific types of inactive state of the subscribers.

Quillen does not make up for the deficiencies of Wick as discussed above.

In the second paragraph on page 6 of the Office Action, the Examiner cited col. 10, lines 35-40 and col. 12, lines 36-50 and Figs. 5-7 of Quillen as disclosing displaying in the graphical user interface the selected subscriber in a visually distinctive manner so as to identify the subscriber being monitored for a state change. However, the Examiner did not explain how the cited text and figures disclose displaying in the graphical user interface the selected subscriber in a visually distinctive manner so as to identify the subscriber being monitored for a state change.

The Examiner asserted in the paragraph bridging pages 3 and 4 of the Office Action that Quillen clearly teaches that the inactive subscribers selected from the list of subscribers are displayed in a visually distinctive manner so as to identify the subscribers being monitored for a state change, because those buddies are clearly shown in the buddy list in figures 5-7. However, it is noted that the buddies in buddy list are other users of an instant messaging program with whom a program user desires to communicate and interact. The buddies may include both active subscribers and inactive subscribers. It is further noted that the buddies are not displayed in a manner visually distinctive (such as a distinctive icon, a distinctive font, a distinctive font color, or a distinctive background color) from any other subscribers.

Quillen describes in col. 10, lines 42-46 that the icon 520 may indicate the online presence of the contact it represents; for example, the shape or color of the icon 520 may be different when the contact is online as opposed to when the contact is not online. However, in Quillen the icon 520 is not displayed in a visually distinctive manner so as to identify the contact represented by the icon 520 is being monitored for a state change. It is noted that in Quillen the shape or color of the icon 520 changes only after the state of

the contact has changed from offline to online. In contrast, in the present invention the subscriber is displayed in a visually distinctive manner so as to identify the subscriber being monitored for a state change, namely before the state of the subscriber has changed from inactive to active.

The other cited references do not make up for the deficiencies of Wick and Quillen.

Accordingly, the cited references, alone or in combination, fail to disclose or suggest each and every element of Claims 1, 38, and 45. Applicants therefore respectfully submit that Claims 1, 38, and 45 define over the prior art. Furthermore, as each of the remaining claims depends from Claims 1 or 38 while reciting additional features, Applicants further respectfully submit that the remaining claims likewise define over the prior art.

Applicants thus respectfully request that the claim rejections under 35 U.S.C. § 103 be withdrawn.

CONCLUSION

Applicants believe that this application is now in full condition for allowance, which action is respectfully requested. Applicants request that the Examiner call the undersigned if clarification is needed on any matter within this Amendment, or if the Examiner believes a telephone interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,

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